REMARKS/ARGUMENTS

Upon entry of the present response, claims 13, 15-20 and 22-26 will have been amended and are being resubmitted for consideration by the Examiner. Additionally claims 27-28 are being submitted for consideration. Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 13-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner notes that the MPEP states that any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. § 112, first paragraph, as failing to comply the written description requirement, and notes that claims 13, 20 recite "the predetermined page of the image page of the image data not including one of the plurality of page of the image data previously received from the mail server". The Examiner has further objected to claims 13 and 20 because of informalities. The Examiner notes that the inclusion of a negative limitation does not further limit the claims.

By the present amendment, Applicant has amended the rejected claims to clarify the scope of the invention. In so doing, Applicant does not agree with the Examiner regarding the language of the claims. In this regard, Applicant notes that there was no negative limitation in the claim. Rather, the claim merely indicated the predetermined

page of decoded image data is different from or distinct from the plurality of pages of the decoded data previously received from the mail server. Nevertheless, as noted above, Applicant has revised the language of the claim to more clearly and distinctly define the features of Applicant's invention.

In the "Response to Arguments", the Examiner indicated that one of Applicant's statements is "somewhat unclear and misleading". It is respectfully submitted that the Examiner is incorrect. The Examiner appears to be misinterpreting the features of the present invention as well as Applicant's prior statement. In this regard, Applicant notes that the present invention has several facilities that are capable of storing data. In this regard, Applicant respectfully directs the Examiner attention to Fig. 4, wherein an image memory area 32 as well as a reception buffer 42 are shown. The reference in the claims and the remarks to storing and a memory, refer to the image memory 32. With respect to the image memory 32, Applicant's statement is correct.

Moreover, in this regard, the Examiner has misinterpreted the disclosure of paragraph [0045]. In this regard, Applicant notes that paragraph [0045] discloses that upon reestablishment of the connection to the POP3 server 10, code data corresponding to the pages before the interrupted pages are deleted from the "reception buffer 42" without any processing (decoding, storage in the image memory area 32, and printing). Thus it is quite clear and explicitly disclosed that the pages before the interrupted page are not stored in memory area 32. This is also clearly shown in the drawings (Fig. 7) where storage of the decoded image data in the memory is shown at step 709 which is after a determination of which data was previously received and which data has not been previously received.

Thus, it is respectfully submitted that Applicant's prior comments regarding HAYASHI are correct and accurate and Applicant's disclosure is clear with respect to how the present invention operates. In other words, the memory recited in the claims is the image memory 32, into which data is transmitted for storage after it determined that the data corresponds to pages after the interrupted page number and after those pages are decoded. Thus, in view of Applicant's specification, the invention is clearly not equivalent to HAYASHI.

Applicant again notes that the memory recited in pending claims corresponds to the image memory area 32, rather than to the reception buffer 42. To clarify this feature, Applicant has recited a decoder in the independent claim 13 and 20, since the image memory area 32 stores image data decoded by the decoder and the reception buffer 42 stores image data that is not decoded by the decoder. Paragraph [0045] of the specification indicates that the character code corresponding to the pages before the interrupted page (received pages) are deleted from the reception buffer 42 without any processing (decoding, storage in the image memory area 32 and printing) when interrupted e-mail data is received. On the other hand, the data corresponding to the pages after the interrupted page number (unreceived pages) are decoded. Thus this limitation is clearly supported by paragraph [0045] of the specification. Therefore, Applicant respectfully requests that the Examiner withdraw the above objection and rejection.

The Examiner has also rejected claims 13-18 and 20-25 under 35 U.S.C. § 103(a) as being anticipated by HAYASHI (U.S. Patent No. 6,862,114) in view of SAITO (U.S. Patent No. 6,128,101) which is commonly assigned with the present application.

The Examiner also has rejected claims 19 and 26 under 35 U.S.C. § 103 (a) as being unpatentable over HAYASHI in view of SAITO and YOSHIDA et al. (U.S. Patent No. 5,031,179).

By the present response, Applicant has amended claims 13, 15-20 and 22-26 for consideration by the Examiner. Applicant respectfully traverses the above rejection based on pending claims 13-26 and will discuss the rejections with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 13-19 generally relate to a receiving Internet facsimile apparatus connectable to a mail server via a network. The receiving Internet facsimile apparatus includes a communicator that receives, from the mail server via the network, an e-mail to which a plurality of pages of image data are attached, and a decoder that decodes the plurality of pages of the image data attached to the e-mail. The receiving Internet facsimile apparatus has a memory that stores the plurality of pages of the decoded image data. The receiving Internet facsimile apparatus further has a controller that determines whether the memory overflows during the reception of the e-mail, and stops receiving the e-mail when it is determined that the memory overflows. The controller also stores, in the memory, a predetermined page of the decoded image data, when an e-mail is received from the mail server after the stop in receiving of the e-mail. The controller is further configured to determine that the predetermined page was not stored in the memory when the e-mail was previously received from the mail server and that the predetermined page is distinct from any of the plurality of pages of

the image data previously received from the mail server. Claims 20-26 generally recite related methods.

Regarding the rejection of independent claims 13 and 20 under 35 U.S.C. § 103(a), HAYASHI relates to a conventional facsimile apparatus.

However, HAYASHI does not disclose an Internet facsimile apparatus. Thus, HAYASHI et al. do not contain any disclosure about an Internet facsimile apparatus. It therefore follows that HAYASHI does not disclose a receiving Internet facsimile apparatus connectable to a mail server via a network and configured to receive, from the mail server via the network, an e-mail to which a plurality of pages of image data are attached.

Further, Applicant respectfully submits HAYASHI merely teaches that a reception-side conventional facsimile apparatus 1) receives, as an NSS signal, a value of the previous number of transmitted sheets, 2) stores all retransmission image data, and 3) deletes image data stored in the previous transmission (*see, e.g.,* column 16, lines 60-65).

However, HAYASHI does not disclose the claimed receiving Internet facsimile apparatus which determines whether the memory overflows during the reception of the e-mail and which stops receiving the e-mail when it is determined that the memory overflows. Rather, HAYASHI merely discloses a reception-side conventional facsimile apparatus which receives, as an NSS signal, a value of the previous number of transmitted sheets, stores all retransmission image data, and deletes image data stored in the previous transmission. (*see, e.g.*, column 16, lines 59-67). In other words, HAYASHI does not contain any disclosure regarding an e-mail to which a plurality of

pages of image data are attached since HAYASHI does not even relate to a receiving Internet facsimile apparatus.

Further, HAYASHI does not disclose the claimed receiving Internet facsimile apparatus which stores, in the memory, a predetermined page of the decoded image data, when the e-mail is received from the mail server after the stop in receiving of the e-mail, the controller being further configured to determine that the predetermined page was not stored in the memory when the e-mail was previously received from the mail server. Rather, HAYASHI merely discloses a reception-side conventional facsimile apparatus which stores all retransmission image data (*see, e.g.*, column16, lines 62-63). In other words, HAYASHI does not contain any disclosure regarding storing, in the memory, a predetermined page of the decoded image data, as recited in at least claim 13.

In this regard, the Examiner asserts in the outstanding Official Action mailed on April 28, 2006, that the Applicant statement is somewhat unclear and misleading in view of Applicant specification paragraph [0045], which indicates "character code data corresponding to the pages before the interrupted pages (received pages) are deleted from the reception buffer (reception storage) without any processing. On the other hand, the data corresponding to the pages after the interrupted page number (un-received pages) are decoded".

However, and as previously noted above, paragraph [0045] actually states that "the character code corresponding to the pages before the interrupted page (received pages) are deleted from the reception buffer 42 without any processing (decoding, storage in the image memory area 32 and printing) when interrupted e-mail data is

received. On the other hand, the data corresponding to the pages after the interrupted page number (un-received pages) are decoded" (emphasis supplied). Applicant submits that the memory recited in claim 13 corresponds to the image memory area 32 of the specification. To even further clarify this feature, Applicant has now amended claims 13 and 20 to add a decoder thereto, since the image memory area 32 stores image data decoded by the decoder while the reception buffer 42 stores image data before being decoded by the decoder.

On the other hand, HAYASHI merely discloses one memory 603b for a facsimile communication as shown in Fig. 2. Thus, in HAYASHI, a reception-side conventional facsimile apparatus stores all retransmission image data in the memory 603b both with respect to receiving as well as with respect to printing.

Thus, as asserted in Applicant's Amendment and Response filed on October 14, 2005 (the arguments of which are expressly incorporated herein), Applicant respectfully submits that in HAYASI (as further described infra), all of the retransmission image data is stored, and HAYASHI has no way to prevent the storage of all such retransmission image data, which unnecessarily consumes memory space (see, e.g., column 16, lines 59-67). In direct contrast, the present invention does not store all retransmission image data. For example, the present invention stores, in the memory, a predetermined page of the decoded image data, when an e-mail is received from the mail server after the stop in receiving of the e-mail. The predetermined page is determined to be a page that was not stored in the memory when the e-mail was previously received from the mail server, and the predetermined page is determined to

be distinct from any of the plurality of pages of the image data previously received from the mail server, thereby avoiding the unnecessary consumption of memory space.

Thus, the pending claims are clearly distinguished over HAYASHI.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 13 and 20 are not disclosed in HAYASHI cited by the Examiner.

In setting forth the rejection, the Examiner relies upon (commonly-assigned) SAITO to supply the shortcomings of HAYASHI. SAITO relates to an e-mail type facsimile apparatus which leaves unacceptable mail in a mail server, and stores the left mail number, message ID of the latest mail as left mail number K and left mail ID. In the next access, the e-mail type facsimile apparatus acquires the message ID of the Kth mail stored in the mail server and compares it with the left mail ID. When both IDs match, the e-mail type facsimile apparatus receives the "K+1"th and subsequent pieces of mail from the mail server.

However, SAITO does not disclose the claimed receiving Internet facsimile apparatus which determines whether the memory overflows during the reception of the e-mail and stops receiving the e-mail when it is determined that the memory overflows. Rather, SAITO determines whether the Mth mail is acceptable and leaves unacceptable mail in the mail server when it is determined that the Mth mail is unacceptable (*see, e.g.,* column 5, lines 12-25, column 6, lines 29-67 and column 7, lines 1-15). In this regard, unacceptable mail relates to mail that cannot be printed, with examples being provided at column 5, lines 16-25. Thus SAITO does not relate to memory overflow but to unprintable mail.

SAITO also does not disclose the claimed receiving Internet facsimile apparatus which stores, in the memory, a predetermined page of the decoded image data attached to the e-mail, when the e-mail is received from the mail server after the stop in receiving of the e-mail, the predetermined page was not stored in the memory when the e-mail was previously received from the mail server. Rather, SAITO compares the message ID of the Kth mail stored in the mail server with the left mail ID, and receives the "K+1"th and subsequent pieces of mail from the mail server when there is a match. In other words, SAITO merely receives a next acceptable e-mail and subsequent acceptable e-mails from the mail server, in the next access, as shown in Fig. 8 (*see, e.g.,* column 6, lines 29-67 and column 7, lines 1-15). Thus, SAITO does not disclose storing, in the memory, a predetermined page of the decoded image data, when the e-mail is received from the mail server after the stop in receiving the e-mail at least since unacceptable mail is not received, decoded and stored in memory even after many receptions from the server since what renders mail unacceptable in SAITO is the format of the mail (rather than a memory overflow) and the format will not change no matter how many receptions of e-mail from the server occur.

In discussing the SAITO document, the Examiner asserts that predetermined page of the image data, not including one of the plurality of pages of the image data being previously received from the mail server. This is, however, not correct because claim 13, describes the predetermined page, as a predetermined page of the decoded image data, when an e-mail is received from the mail server after the stop in receiving of the e-mail. In other words, the predetermined page is a page not received in a previous e-mail reception but is received during a current e-mail reception as set forth in

the last paragraph of claim 13. However, as previously noted, SAITO does not disclose such a feature because in SAITO unacceptable mail is mail that cannot be received by the device due to format issues or similar problems described at column 5, lines 15-25. Thus, such unacceptable mail will not be received by the apparatus even after numerous receptions. In other words, a document which is not received during a first reception will not be received during a second reception as is made explicitly clear by Fig. 8 of SAITO and the disclosure associated therewith.

Thus, the pending claims are also clearly distinguished over SAITO.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 13 and 20 are not disclosed in SAITO cited by the Examiner. The pending claims are also submitted to be patentable over the Examiner's proposed combination, since neither HAYASHI nor SAITO, either taken alone or in any proper combination, discloses the features recited in Applicants' claims 13-18 and 20-25.

Furthermore, the Examiner has not set forth a proper motivation for combining HAYASHI and SAITO. In HAYASHI, all of the retransmission image data is stored in the memory 603b for both receiving and printing in a conventional facsimile apparatus, as discussed above. In other words, HAYASHI does not contain any suggestion for decoding some of the pages of image data attached to the e-mail and for storing the decoded pages during an e-mail reception subsequent to a memory overflow. On the other hand, SAITO, which does not at all deal with memory overflow but with unacceptable mail, compares the message ID of the Kth mail stored in the mail server with the left mail ID, and receives the "K+1"th and subsequent pieces of mail from the mail server when both IDs match. In other words, SAITO merely receives, from the

mail server, an acceptable next mail and subsequent acceptable mails stored in the mail server, but does not receive unacceptable mail at all.

In setting forth the combination of HAYAHSI and SAITO, the Examiner asserted that they are analogous and thus that it would have been obvious to combine the teachings of SAITO into the apparatus and method of HAYASHI. However, as previously note, there is no motivation for such a combination. In other words, and as previously noted, SAITO does not in any way retransmit (i.e., receive) mail that has not been previously received because the issue with which SAITO is dealing is mail that cannot be received due to its being unacceptable (i.e., being in a format that does not allow it to be output normally (column 6, lines 44-45) and as described more fully at column 5, lines 14-21).

Moreover, Applicant respectfully submits that merely because two references are from an analogous field, that alone does not provide adequate motivation for the combination of the features thereof. In addition, Applicant notes that while SAITO and HAYASHI are from a broadly defined "analogous" art, in fact, there are numerous significant and substantial differences therebetween. In particular, HAYASHI deals with a facsimile machine that does not involve a server or Internet connection in any fashion. On the other hand, SAITO deals with an e-mail type facsimile machine. Thus, while the lowest common denominator of these two documents can be considered that they relate to facsimile transmission, it is respectfully submitted that this feature alone is an inadequate basis for the combination of features thereof.

Furthermore, with respect to the Examiner's rejection of dependent claims 19 and 26 based on HAYASHI in view of SAITO and YOSHIDA et al., Applicant submits

that dependent claims 19 and 26 are respectively dependent from allowable independent claims 13 and 20, which are allowable for at least the reasons discussed supra. Thus, these dependent claims are also allowable for at least the reasons discussed supra. Further, these and all dependent claims set forth a further combination of elements and/or features neither taught nor disclosed by any proper combination of the applied references.

By the present response, Applicant has submitted several additional claims for consideration by the Examiner. These claims further define the scope of coverage to which Applicant is entitled and clearly define over the prior art of record in the present application. Accordingly, examination and an indication of the allowability of these claims is respectfully requested, in due course.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.

Although the status of the application is after final rejection, Applicant submits that entry of the amendment is proper under 37 C.F.R. § 1.116. In particular, no new issues are being presented. It is believed that the Examiner has searched and considered the claim limitations as they were discussed in the specification. The Examiner is respectfully requested to exercise his discretion in this regard.

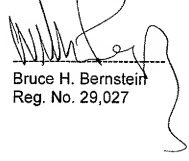
SUMMARY AND CONCLUSION

Applicant has amended the rejected claims for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and have contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Satoshi YASHIKI



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